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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/803,396	03/09/2001	Akira Nonaka	09812.0625-00000	8707		
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				KUCAB, JAMIE R		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/803,396	NONAKA, AKIRA	
	Examiner	Art Unit	
	JAMIE KUCAB	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-18,31,33-35 and 50 is/are pending in the application.
 4a) Of the above claim(s) 50 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,3-18,31 and 33-35 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/28/09</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2009 has been entered.

Acknowledgements

2. In accordance with the RCE above, claims 1, 3-18, 31, 33-35, and 50 are pending in the application. Claim 50 is withdrawn from consideration. Claims 1, 3-18, 31, and 33-35 are examined below.

3. This Office action is given Paper No. 20090611 for reference purposes only.

Specification

4. The disclosure is objected to because of the following informalities: the word "hush" is used in numerous places in the drawings and written description. It appears that Applicant intends "hush" to mean "hash." Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 112, 1st Paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3-18, 31, and 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The element “examiner” having the claimed functionality was not previously disclosed, nor could antecedent basis be found in the specification.

Claim Rejections - 35 USC § 112, 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3-18, 31, and 33-35 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 1 and 31, Applicant’s recitation “examiner” would be unclear to a person having ordinary skill in the art. Applicant’s latest amendment replaced “examining means” with “examiner.” Because the functional language modifying “examiner” is the same as that which previously modified “examining means,” the

Examiner is interpreting these to be identical elements. Although 35 USC 112, 6th paragraph is now clearly not invoked, it is still unclear in light of Applicant's specification how many and what type of structures are required by this limitation. Based on pg. 1 (4th line from the bottom) and pg. 4, lines 12-13 of Applicant's replacement section V of the Appeal Brief filed April 10, 2008, the structure corresponding to the previously claimed "examining means for..." is the Electronic Music Distribution System 1 (Fig. 1). First, it is unclear how many structures are encompassed by this "examiner." EMD System 1 as shown in Fig. 1 appears to contain five different computers. Is this examiner all five computers? Is it one of the computers? Is it an apparatus contained within each of the computers? Second, the "examiner" also appears to be the same system as is recited in the preamble of claim 1. Is the examiner the entire system? Or is it a specific structure within the system? Is the scope of claim 31 an apparatus within the system or the entire EMD system? Applicant later further confused the claim by arguing (pgs. 12-13 of Applicant's Remarks filed August 29, 2008) that the structure corresponding to the previously claimed "examining means for..." was the end service center 100. Applicant made no specific argument in support of this and merely pointed to eight figures and nine pages of specification. For purposes of comparison with the prior art, the Examiner is interpreting the claimed "examiner" to be a computer. Appropriate correction is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3-18, 31, and 33-35 are rejected under 35. U.S.C. § 103 as being unpatentable over Ryan (US 5,513,260 A) in view of Stefik (US 5,629,980 A) and in further view of Vogel (US 5,446,488).

Claims 1, 31, and 50:

12. Ryan (See at least Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) discloses a means for reproducing content (CD-player), a recorder (CD-recorder) and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Ryan does not explicitly disclose copying digital data on an optical medium. Stefik, however, in at least column 1, lines 10-24 teaches the reproduction of optical media. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional

functional equivalents and between reproduction and recording selection and control must always exist.

13. Ryan does not disclose the newly-added limitation of wherein said usage space information indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data. Stefik, however, in at least Figure 15 as well as associated text does disclose the controlled copying of digital data in a digital rights management environment to include system information (items 1504, 1505, 1506), ownership rights information (items 1501- 1503), format of digital data (item 1506), and profit distribution (items 1517-1525). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cd recording system of Ryan with Stefik' s Digital Rights Management techniques because, "A fundamental issue facing the publishing and information industries as they consider electronic publishing is how to prevent the unauthorized and unaccounted distribution or usage of electronically published materials. Electronically published materials are typically distributed in a digital form and recreated on a computer based system having the capability to recreate the materials. Audio and video recordings, software, books and multimedia works are all being electronically published. Companies in these industries receive royalties for each accounted for delivery of the materials, e.g. the sale of an audio CD at a retail outlet. Any unaccounted distribution of a work results in an unpaid royalty (e.g. copying the audio recording CD to another digital medium)" (Stefik: column 1, lines 10-24).

14. Ryan does further discloses an examining means for deciding whether said recording medium is of a first type having a configuration enabling recorded data to be effectively read out by performing authentication processing or of a second type having no such configuration and enabling read out of the recorded data without authentication (col. 3, line 63 - col. 4, line 11), examining means for deciding whether said reproducing apparatus is of a first type for reproducing after the authentication processing or of a second type for reproducing without that processing (col. 3, line 63 - col. 4, line 11), and examining means for deciding whether said recording apparatus is of a first type for recording after the authentication processing or of a second type for recording without that processing (col. 3, line 63 - col. 4, line 11). However, Ryan does not explicitly teach an examining means that decides whether data is to be distributed in encrypted or unencrypted form.

15. Stefik does teach a means for distributing data in its unencrypted state, but does not teach this in combination with the sending of data in its encrypted state (Table 2).

16. However, Vogel does teach an examining means to decide whether data should be transmitted in its encrypted or unencrypted state (col. 3, lines 28-48. Therefore, it would have been obvious to one of ordinary skill in the art to combine the references of Vogel and Ryan for the useful purpose of either forcing people to pay to be able to receive and decode the programs, or on the contrary, allowing anyone to view the program without payment, as taught by Vogel.

Claim 3:

17. Regarding disabling limitations of claim 3, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 4:

18. Regarding disabling limitations of claim 4, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 5:

19. Regarding the enabling limitations claim 5, Ryan (See Fig 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder

and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 6:

20. Regarding the enabling limitations claim 6, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 7:

21. Regarding disabling limitations of claim 7, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 8:

22. Regarding disabling limitations of claim 8, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 9:

23. Regarding the enabling limitations claim 9, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 10:

24. Regarding the enabling limitations claim 10, Ryan (See Fig. 1, Col. 1, liras 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 11:

25. Regarding disabling limitations of claim 11, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 12:

26. Regarding disabling limitations of claim 1 2, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 13:

27. Regarding the enabling limitations claim 13, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 3 0-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 14:

28. Regarding the enabling limitations claim 14, Ryan (See Fig. 1, Col. 1, lines 60-65, C o 1. 3, lines 30- 65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 15:

29. Regarding disabling limitations of claim 15, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 16:

30. Regarding disabling limitations of claim 16, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 17:

31. Regarding the enabling limitations claim 17, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 18:

32. Regarding the enabling limitations claim 18, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear

text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 33:

33. Regarding disabling limitations of claim 33, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 34:

34. Regarding disabling limitations of claim 34, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 35:

35. Regarding disabling limitations of claim 35, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Response to Arguments

36. Applicant's arguments with respect to the 112 2nd ¶ rejections of claims 1 and 31 due to the recitation "examining means for..." have been fully considered but are not persuasive. See the revised rejection above.

37. Applicant's arguments with respect to the 103 rejections of the claims have been fully considered but they are not persuasive. Ryan discloses an examining means (black boxes). Stefik discloses an examining means (Authorization Repository 202 or Master Repository 204). Vogel discloses an examining means (the broadcaster). The combination of these references discloses the functionality of Applicant's claimed examining means as discussed in the above rejection.

Conclusion

38. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.
39. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.
40. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.
41. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

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